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PCT LEGAL ADMINISTRATION

In re Application of	:	
OFER ADAN et al.	:	
Application No.: 10/544,122	:	DECISION ON PETITION
PCT No.: PCT/US03/38140	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 24 November 2003	:	
Priority Date: 05 February 2003	:	
Attorney Docket No.: 6317P028PCT	:	
For: A METHOD FOR MEASURING AND	:	
REDUCING ANGULAR DEVIATIONS	:	
OF A CHARGED PARTICLE BEAM	:	

This decision is in response to applicants' "Renewed Petition under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office (PTO) on 08 April 2011.

BACKGROUND

On 24 November 2003, applicants filed international application PCT/US03/38140 which claimed a priority date of 05 February 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 05 August 2005.

On 01 August 2005, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 23 January 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for providing the oath or declaration later than 30 months from the priority date was required. The notification set a two (2) month period for response.

On 08 September 2006, applicants filed "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)." In a decision dated 13 November 2006, applicants' petition under 37 CFR 1.137(b) was dismissed without prejudice.

On 15 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned.

On 27 August 2010, applicants filed "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)." In a decision dated 08 February 2011, applicants' petition under 37 CFR 1.137(b) was dismissed without prejudice.

On 08 April 2011, applicants filed "Renewed Petition under 37 CFR 1.137(b)" considered herein.

DISCUSSION

STATUTE AND REGULATION

35 U.S.C. § 41(a)(7) provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." Specifically, 35 U.S.C. § 41(a)(7) provides:

On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.

37 CFR 1.137(b) provides:

Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;*
- (2) The petition fee as set forth in § 1.17(m);*
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and*
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.*

OPINION

Where there is a question whether the delay was unintentional, applicant must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). The circumstances of the above-identified application raise a question whether the delay was "unintentional":

Where the applicant deliberately permits an application to become abandoned (*e.g.*, due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). . . . A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional delay within the meaning of 37 CFR 1.137(b) because: . . . (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and prosecution expenses.

See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997)(citations omitted).

As previously stated, applicant failed to file a proper response to the Notification of Missing Requirements dated 23 January 2006. The present petition states that (1) petitioner was not aware of the Decision on Petition mailed 13 December 2006 until June 2009 (since the Decision was mailed to the co-assignee) and (2) petitioner requested instructions from the assignee regarding the handling of this application, but did not receive instruction until June 2010. Petitioner's present statement has been reviewed, however, the explanation is insufficient to establish that the entire delay was unintentional. Specifically, the statement fails to provide specific details during the time period mentioned above. Therefore, applicants must provide additional information to explain the failure to timely file the required replies sufficient to establish that the entire delay in filing the present renewed petition was unintentional. (It is noted that the Office may require additional information if there is a question to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional. See Manual of Patent Examining §711.03(c)(III)(C) and (D).)

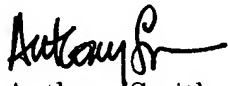
Based on the above, applicant has not satisfied all the requirements for a grantable petition for revival under 37 CFR 1.137(b).

CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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